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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,889	03/06/2002	Minoru Takebe	211A 3160 PCT	2509

7590 01/31/2005
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EXAMINER

KIM, JENNIFER M

ART UNIT PAPER NUMBER

1617

DATE MAILED: 01/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/070,889	Applicant(s) TAKEBE, MINORU	
	Examiner Jennifer Kim	Art Unit 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 8 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The response filed July 14, 2004 have been received and entered into the application.

Action Summary

The rejection of claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Takebe et al. (U.S. Patent No. 5,885,632) is being maintained for the reasons stated in the previous office action.

Response to Arguments

Applicant's arguments filed July 14 2004 have been fully considered but they are not persuasive. Applicant argues that the claimed invention of Takebe et al. is different from the claimed invention of Applicant's application because claims 1-7 of Takebe et al. are all essentially a process as well as instant claims 1-7 are all a product. This is not persuasive because Takebe et al. fully teaches all the element required by the instant claims, particularly TABLE 3, column 10, lines 43-68, teaches the daizein containing preparation or a food product containing isoflavone aglycone are clearly taught. Applicant argues that since this is conflict between an application and a patent having different inventions, different inventorship and which was commonly owned at

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the time the application was filed, the proper rejection would have been an obviousness double patenting rejection and that the terminal disclaimer has been filed. This is not persuasive because the instant claims at issue are **fully** and clearly taught by the cited reference and the publication or issue date of the reference is more than 1 year prior to the effective filing date of the application, therefore the cited reference qualified as prior art under 35 U.S.C. 102(b). The cited reference is a statutory bar under 35 U.S.C. 102(b) and thus cannot be overcome by the Terminal Disclaimer.

In view of the above Office Action of 1/14/2004 is deemed proper and asserted with full force and repeated herein to obviate applicants' claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Takebe et al. (U.S. Patent No. 5,885,632).

Takebe et al. teach a food product prepared from a pulse crop (grains) as a starting material comprising fermentation to inhibit contaminants wherein the fermentation time depends upon the type of koji mold and a koji preparation comprising

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cooking pulse crop and hydrolyzing koji preparation by adding water comprising at least 70 wt% isoflavone aglycone (daizein) set forth in claims 1-7. (title, abstract, column 6, lines 48-49, column 7, lines 15-17, column 8 particularly, table 3, column 12, claims 7-10).

Applicant's recitation in claims 1-7 of an intended use of the material as being an anti-obesity material does not represent a patentable limitation since such fails to impart any physical limitation to the same composition taught by the prior art. Moreover, the oral supplement set forth in claim 7 would be inherent in the same composition taught by the prior art as being a food product.

For these reasons the claimed subject matter is deemed to fail to patentably distinguish over the state of the art as represented by the cited references. The claims are therefore properly rejected under 35 U.S.C. 102(b).

None of the claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the


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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Kim whose telephone number is 571-272-0628. The examiner can normally be reached on Monday through Friday 6:30 am to 3 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Sreenivasan Padmanabhan
Supervisory Examiner
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Jmk

January 28, 2005